

Remarks

This Application has been carefully reviewed in light of the Office Action mailed February 25, 2004. Applicant believes all claims are allowable without amendment. No claims have been amended. However, Applicant respectfully provides these remarks. Applicant respectfully requests reconsideration and allowance of all pending claims.

The Claims are Allowable over *Chow* and *Wimble*

The Examiner rejects Claims 1-56 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,226,693 to Chow et al. ("*Chow*") and further in view of U.S. Patent 5,778,230 to Wimble et al. ("*Wimble*"). Applicant respectfully disagrees.

Independent Claims 1, 9, 13, and 19

Chow fails to disclose, teach, or suggest a system for managing event publication and subscription for event producer-consumers of heterogeneous types using a plurality of mappers each specific to a particular type of event producer-consumer, as recited in independent Claim 1. The Examiner argues that Column 9, lines 16-19 of *Chow* provides such teaching:

As to applicant's argument *Chow* disclosed the objects can register actions for a specific logical event on a given target object with event manager. These actions can be procedure/method calls or scripts. Events are designed in an object oriented fashion and the user can subclass the abstract action object and create new custom objects (col. 9, lines 16-19).

(Office Action, Page 10) Even assuming for the sake of argument that the Examiner's summary of Column 9, lines 16-19 of *Chow* is accurate, that portion of *Chow*, and all other portions of *Chow*, would still fail to disclose, teach, or suggest a system for managing event publication and subscription for event producer-consumers of heterogeneous types using a plurality of mappers each specific to a particular type of event producer-consumer, as recited in independent Claim 1.

Furthermore, the Examiner admits in the Office Action that *Chow* fails to fully disclose that a "physical event manager comprises: a first mapper specific to the first type of the first event producer-consumer and operable to translate between the logical event manager and the first event producer-consumer; and a second mapper specific to the second

type of the second event producer-consumer and operable to translate between the logical event manager and the second event producer-consumer.” (See Office Action, Pages 2-3) Accordingly, it would seem that even the Examiner would admit that *Chow* fails to disclose, teach, or suggest a system for managing event publication and subscription for event producer-consumers of heterogeneous types using a plurality of mappers each specific to a particular type of event producer-consumer, as recited in independent Claim 1.

Accordingly, Applicant respectfully submits that *Chow* is wholly inadequate as a reference against independent Claim 1.

Moreover, as discussed in a previous Response, *Wimble* fails to make up for the clear deficiencies of *Chow*. *Wimble* discloses a debugging system that includes a Logical to Physical Manager that maps a physical event into a set of logical events. (Abstract; Column 1, Lines 15-18; Column 10, Line 63-Column 11, Line 2; Column 11, Lines 24-29; Column 12, Lines 46-51) However, *Wimble* fails to disclose, teach, or suggest a system for managing event publication and subscription for event producer-consumers of heterogeneous types using a plurality of mappers each specific to a particular type of event producer-consumer, as recited in independent Claim 1. *Wimble* also contains no disclosure, teaching, or suggestion of a logical event manager operating in cooperation with a separate physical event manager as recited in independent Claim 1. Furthermore, *Wimble* fails to disclose, teach, or suggest a physical event manager that is in communication with “the logical event manager, a first event producer-consumer of a first type, and a second event producer-consumer of a second type” and that comprises “a first mapper specific to the first type of the first event producer-consumer and operable to translate between the logical event manager and the first event producer-consumer” and “a second mapper specific to the second type of the second event producer-consumer and operable to translate between the logical event manager and the second event producer-consumer,” where the first and the second event producer-consumers are of heterogeneous types as recited in independent Claim 1.

As clearly illustrated in Figure 13, *Wimble* merely discloses a Logical to Physical Manager that is in communication with a single primitive event object and thus performs only one type of mapping for the single primitive event object. (See Column 10, Lines 43-44)

Accordingly, *Wimble* has absolutely no need for a first mapper and a second mapper each specific to a different type of event producer-consumer as recited in independent Claim 1. *Wimble* fails to even disclose, teach, or suggest heterogeneous types of event producer-consumers. Thus, *Wimble* clearly fails to disclose, teach, or suggest a physical event manager that is in communication with “the logical event manager, a first event producer-consumer of a first type, and a second event producer-consumer of a second type” and that comprises “a first mapper specific to the first type of the first event producer-consumer and operable to translate between the logical event manager and the first event producer-consumer” and “a second mapper specific to the second type of the second event producer-consumer and operable to translate between the logical event manager and the second event producer-consumer,” where the first and the second event producer-consumers are of heterogeneous types as recited in independent Claim 1.

Thus, even assuming for the sake of argument that there was the required suggestion or motivation to combine *Chow* with *Wimble* as the Examiner proposes, the proposed *Chow-Wimble* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1.

Furthermore, the references relied upon by the Examiner fail to provide any teaching, suggestion, or motivation to modify *Chow* by combining *Chow* with *Wimble* or to otherwise combine the reference as proposed by the Examiner.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant’s disclosure. *See Id.* (citations omitted). “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

“range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See*

id. See also, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

The Examiner argues:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the physical event manager comprises: a first mapper operable to translate between the logical event manager and the first event producer consumer; and a second mapper operable to translate between the logical event manager and the second event producer consumer as taught by Wimble in the method of Chow to increase the functionality of the system by making it more versatile.

(Office Action, Page 3) The Examiner further argues, “Wimble will make the user more independent without having any physical knowledge of GUI and reduce the burden by making the environment independent and also error resistance in the method of Chow.” (Office Action, Page 9)

As discussed above, as clearly illustrated in Figure 13, *Wimble* merely discloses a Logical to Physical Manager that is in communication with a single primitive event object and thus performs only one type of mapping. (See Column 10, Lines 43-44) Accordingly, *Wimble* has absolutely no need for a first mapper and a second mapper as recited in Claim 1, and thus *Wimble* clearly provides no teaching, suggestion, or motivation for the proposed combination. *Chow* also clearly fails to provide any such teaching, suggestion, or motivation. Applicant respectfully submits that the Examiner's conclusions that the proposed

combination would “increase the functionality of the system” and “make the user more independent” are entirely insufficient in light of the strict M.P.E.P. and Federal Circuit guidelines discussed above.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with all of its dependent claims. Independent Claims 9, 13, and 19 recite certain limitations similar to those recited in independent Claim 1 with respect to mapping for heterogeneous types of event producer-consumers.² Accordingly, Applicant also respectfully requests reconsideration and allowance of independent Claims 9, 13, and 19, together with all of their dependent claims.

Independent Claims 23, 34, 45, and 56

For at least the reasons discussed above, *Chow* is also wholly inadequate as a reference against independent Claim 23.

Wimble fails to make up for the clear deficiencies of *Chow* with respect to independent Claim 23. As discussed above, *Wimble* merely discloses a Logical to Physical Manager that is in communication with a single primitive event object and thus performs only one type of mapping for the single primitive event object. Thus, *Wimble* fails to disclose, teach, or suggest a physical event manager in communication “a plurality of event producer-consumers, each event producer-consumer being of a particular type, the plurality of event producer-consumers being of heterogeneous types,” as recited in independent Claim 23. Moreover, *Wimble* has absolutely no need for multiple mappers that each correspond to a particular type of event producer-consumer. Thus, *Wimble* fails to disclose, teach, or suggest “a plurality of mappers each corresponding to a particular type of event producer-consumer,” where each mapper is operable to “translate the particular type of signal received from the corresponding particular type of event producer-consumer into a logical event for communication to the logical event manager” and to “translate the logical event received from the logical event manager into a particular type of signal indicative of a physical event for communication to the corresponding particular type of event producer-consumer,” as

² Applicant does not necessarily agree with the Examiner's statement that Claims 12-13, 18-19, and 22 "have the same limitations" as Claim 1. (Office Action, Page 4)

recited in independent Claim 23. *Wimble* also contains no disclosure, teaching, or suggestion of a logical event manager operating in cooperation with a separate physical event manager as recited in independent Claim 23.

Thus, even assuming for the sake of argument that there was the required teaching, suggestion, or motivation to combine *Chow* with *Wimble* as the Examiner proposes, the proposed *Chow-Wimble* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 23.

Furthermore, as discussed above, the requisite teaching, suggestion, or motivation in the prior art to combine *Chow* with *Wimble* is entirely lacking.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 23, together with all of its dependent claims. Independent Claims 34, 45, and 56 recite certain limitations similar to those recited in independent Claim 23 with respect to mapping for heterogeneous types of event producer-consumers.³ Accordingly, Applicant also respectfully requests reconsideration and allowance of independent Claims 34, 45, and 56, together with all of their dependent claims.

³ Applicant does not necessarily agree with the Examiner's statements that Claims 32-33, 43-44, and 54-55 "have the same limitations" as Claims 30-31 and that Claim 56 "has the same limitations" as Claim 23. (Office Action, Page 9)

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, the Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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